

## **REMARKS**

### **Status**

Claims 1, 3-20 and 23-28 are pending in this Office Action. Claims 5-7, 9 and 24-26 were withdrawn from consideration in response to a restriction requirement, and it was claims 1, 3, 4, 8, 10-20, 23, 27 and 28 which were the subject of this Office Action. The present amendment cancels claim 27. Accordingly, claims 1, 3, 4, 8, 10-20, 23 and 28 are the subject of this response.

### **The Office Action**

In the Office Action mailed August 3, 2011, claim 27 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite with regard to the recitation of certain trademarked names. Claim 27 was also objected to insofar as several of the recited species are duplicates.

Claims 1, 3, 4, 8, 10-20 and 23 were rejected under 35 U.S.C. §112, first paragraph, as not being fully enabled by the specification.

Claims 1, 3, 4, 11-20, 23, 27 and 28 were rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,728,373 of Alert taken in view of U.S. Patent 5,118,707 of Chatterjee.

Applicant thanks the Examiner for the Office Action, for the thorough explanation of the basis of the rejections, and for the withdrawal of rejections previously made.

### **The Amended Claims**

By the present amendment, claim 1 has been rewritten to include the subject matter of claim 27 reciting a Markush grouping of ACE inhibitors and/or angiotensin II receptor antagonists. In making this amendment, trademark names and duplicate entries were removed from the Markush grouping thereby addressing the Examiner's objections and rejections with

regard to claim 27. In view of the amendment to claim 1, claim 27 has been canceled. The present amendment also amends claim 3 so as to depend from claim 1.

**Claim Objections and Rejections with Regard to Claim 27**

Claim 27 has been canceled; therefore, all objections and rejections thereof are moot.

**Enablement**

Claims 1, 3, 4, 8, 10-20 and 23 were rejected under 35 U.S.C. §112, first paragraph, as not being fully enabled by the specification. The subject matter of previously pending claim 27 has been inserted into claim 1. Previous claim 27 was fully enabled by the specification as originally filed and was not subject to any rejection on the grounds of enablement. Therefore, claim 1, as well as all claims dependent therefrom, are now fully enabled and this rejection is overcome.

**The Rejections under 35 U.S.C. §103**

Claims 1, 3, 4, 11-20, 23, 27 and 28 were rejected under 35 U.S.C. §103 as being unpatentable over the Alert 5,728,373 patent taken in view of the Chatterjee 5,118,707 patent. The Alert patent was cited for its teaching of the use of thiol compounds, and in particular captopril, in compositions for preventing photo damage to the skin. The Chatterjee patent was cited for its teaching of the fact that skin wrinkles can be caused by photo damage to the skin. On this basis, the Examiner is holding that it would be obvious to use the captopril-containing sun protective compositions of Alert for the “reduction of the visible signs of fine lines on the skin of an individual” as recited in the claims at issue. Applicant respectfully submits that in making this rejection, the Examiner is confusing the prevention of light induced damage to the skin with methods for reducing the visible signs of preexisting fine lines on the skin.

The Alert patent is very clearly directed to preventative/protective methods with regard to UV induced skin damage. In this regard see, for example, column 1, lines 48-54; column 2, lines 15-22; and column 6, lines 12-21. As described in Alert, the mode of operation of the thiol compounds is to act as a free radical trapping agent, an antioxidant, and a material which prevents bonding of photoproducts to lipids, DNA, and proteins, all mechanisms being consistent with operation in a mode of damage prevention.

In the Office Action, the Examiner points specifically to a passage in Alert at column 2, lines 43-47, wherein it is disclosed that:

The thiols or thiol derivatives according to the invention or the cosmetic or dermatological formulations according to the invention furthermore astonishingly are suitable for controlled prophylaxis and/or treatment of UV-induced skin damage.

Applicant respectfully submits that this statement by no means indicates or suggests that thiols or thiol derivatives in fact are capable of reducing the visible appearance of already existing fine skin lines. Reading the entire specification of Alert would not suggest to one of skill in the art that the compositions therein could operate to reduce the visible appearance of already-existing fine skin lines. The overwhelming teaching in Alert is that thiols provide **protection** against damage by UV radiation. In fact, the entire argumentation for the effect of the disclosed thiols and thiol derivatives presented in Alert is based upon a prophylactic effect as, for example, can be seen in the passage at column 2, lines 15-22, which states:

thiols or thiol derivatives according to the invention ...  
provide better **protection** against damage by UV radiation  
act better as an **antioxidant**  
act better as an agent which **traps free radicals**  
**prevent** bonding of harmful photoproducts to lipids, DNA and proteins ... (emphasis added).

The Chatterjee patent teaches that skin wrinkling can result from exposure to UV light. However, even in view of this teaching, a skilled person, having access to the teaching of Alert, would not have been prompted to reduce or remove the visible appearance of **already existing** fine skin lines with captopril or any other ACE inhibitor. First of all, it must be kept in mind that UV induced skin damage may comprise any of a number of different skin conditions including skin cancers, scaling, redness, blistering, and peeling. Alert does not refer to treatment of any specific induced skin damage.

Furthermore, it should be kept in mind that to the skilled person, a process of **preventing UV induced skin damage** is completely different from **reducing the visible appearance of fine skin lines**. Thus, the Alert process of preventing UV induced skin damage involves inhibiting UV light from reaching the skin and/or inhibiting UV induced free radical damage to the skin. In contrast, the process of reducing the appearance of already existing fine skin lines is very different and, as detailed in the specification, focuses on connective tissue in the dermal and epidermal layers or the underlying physiological conditions of the vascular tissue. Without being bound by speculation, Applicant hypothesizes that ACE inhibitors and/or angiotensin II receptor antagonists may reduce the formation of uneven collagen deposits in aging and prematurely aged skin, thus reducing the visible appearance of fine skin lines. Thus, based on the disclosure of Alert and Chatterjee, a skilled person would have had absolutely no expectation of success in the presently claimed **reduction of the visible signs of fine lines on the skin by utilizing captopril or another ACE inhibitor and/or angiotension receptor antagonist**.

The Supreme Court of the United States in *KSR International Co. v. Teleflex, Inc.*, 550 US 398, 82 USPQ2d 1385 (2007) set forth guidelines for determining the obviousness of a claimed invention. The United States Patent and Trademark Office subsequently issued

examination guidelines in this regard, and they are summarized in MPEP 2141. In these guidelines, the MPEP cautions Examiners against applying the teaching-suggestion-motivation (TSM) test of *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966) in an overly formalistic manner. Mere existence of elements in the prior art does not support a holding of obviousness. An examiner must look to the problem the patentee was trying to solve (*KSR* at 1397).

In the present case, Applicant is not looking to prevent photo induced skin damage, but rather is seeking to reduce the visible appearance of fine skin lines. As such, one of skill in the art faced with Applicant's problem would not look to the teaching of Alert with regard to some protective formulations and, as discussed above, the brief reference to prophylactic/therapeutic usage in no way suggests that the compositions of Alert would function to reduce the visible appearance of already existing fine skin lines. Likewise, the discussed modes of operation of the invention of Alert would suggest to one of skill in the art that these compositions would not have utility for the reduction of the visible appearance of fine skin lines. Thus, under the guidelines of *KSR* there is no showing or suggestion in Alert which would make obvious those compositions for Applicant's intended method of reducing the visible appearance of fine skin lines. As stated in the MPEP, the Patent Office has cautioned examiners that:

When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions" (citing to *KSR* at 1396).

As discussed above, Applicant's claimed method of reducing the visible appearance of fine skin lines is not merely the predictable use of prior art elements according to their

established functions but a new and unanticipated use for ACE inhibitors and/or angiotensin II receptor antagonists. In view thereof, the claims at issue are novel and nonobvious.

**Claims 8 and 10 Are Patentable**

Claims 8 and 10 were not subject to the foregoing rejection under 35 U.S.C. §103. The sole rejection of these claims was with regard to enablement under 35 U.S.C. §112, first paragraph. Given the fact that these claims depend from now-amended claim 1 and include all of the limitations of previously pending claim 27, which was not rejected as lacking enablement, these claims are per se allowable.

**Conclusion**

In view of the foregoing amendments and remarks, this application is in condition for allowance.

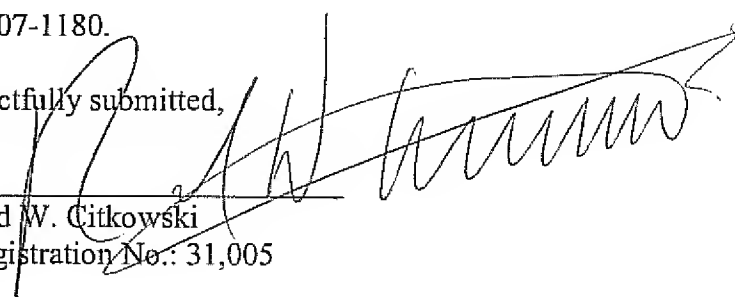
This amendment is being submitted after the entry of a final rejection. The Examiner is respectfully requested to give consideration to the remarks and amendments made herein and enter this response since it places the application in condition for allowance or, alternatively, narrows and clarifies issues for appeal.

Any questions, comments, or suggestions the Examiner may have should be directed to the undersigned attorney.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 07-1180.

Dated:

Respectfully submitted,

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